



MS APPEAL BRIEF - PATENTS
PATENT
0879-0346P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals

Daisuke ITO et al.

Appeal No.:

Appl. No.: 09/933,197

Group: 2615

Filed: August 21, 2001

Examiner: H. LONG

Conf.: 6456

For: ELECTRONIC CAMERA AND REMOTE-CONTROL
OPERATION SYSTEM FOR EXTERNAL APPARATUS

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 16, 2004

Sir:

Transmitted herewith is a Reply Brief on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on October 18, 2004.

☐ An extension of time under 37 C.F.R. § 1.136(b) to requested on and was approved on .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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OPERATION SYSTEM FOR EXTERNAL APPARATUS

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)

MS APPEAL BRIEF - PATENTS

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

December 16, 2004

Sir:

Appellants submit herewith a Reply Brief in response to the Examiner's Answer dated October 18, 2004.

ISSUES ON APPEAL

The issue to be resolved in this application is:

Claims 1, 3-4, 6, 10, 12-14, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* (USP 5,953,481) (hereinafter "*Watanabe*") in view of *Freeman* (USP 5,579,239) (hereinafter "*Freeman*");

Claims 2, 5, 7, 9, 11, 15, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Freeman* and *Matsumoto* (USP 5,796,428) (hereinafter “*Matsumoto*”);

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Freeman* and further in view of *Peters* (USP 6,601,093) (hereinafter “*Peters*”);

Claims 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Freeman* and *Matsumoto* and further in view of *Peters*;

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Freeman* and *Peters*; and

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Freeman* and *Matsumoto* and further in view of *Peters*.

NEW POINTS OF ARGUMENT RAISED BY EXAMINER’S ANSWER

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner’s Answer. Appellants do not disagree with paragraphs (1)-(9) of the Examiner’s Answer. Appellants maintain their position outlined in the Appeal Brief filed July 30, 2004, regarding the claim rejections as reproduced in paragraph 10 of the Examiner’s Answer. The specific new points of argument that are raised in paragraph (11) to which Appellants disagree are as follows:

1. The Examiner introduces new arguments that she is not incorporating the camera 1 and the remote unit 2 of *Freeman* to support her rejection of the claims and merely relies on the teachings of *Freeman* to teach wireless transmission of image data. Appellants response to these assertions are discussed in paragraph 1 below.

2. The Examiner introduces support for her rejection of claim 24 by asserting that the *Peters* reference cures the deficiencies of the primary and secondary references. Appellants response to this assertion is discussed in paragraph 2 below.

RESPONSE

1. THE EXAMINER'S ASSERTION THAT THE MERE TEACHING OF TRANSMITTING IMAGE DATA WIRELESSLY IS SUFFICIENT TO CURE THE DEFICIENCIES OF THE TEACHING OF *WATANABE*

The Examiner asserts that she never relied on the purported combination of camera 1 and video recorder 2 of *Freeman* in order to teach the present invention of an electronic camera transmitting image data wirelessly as she previously asserted in support of her rejections wherein she refers to "the camera-integrated device (1,2)". Based upon this statement, it is evident that the Examiner concedes Appellants' arguments included in the Appeal Brief. However, the Examiner now provides purported alternative support for the claim rejections. The Examiner is now asserting that she is merely relying on *Freeman* to teach transmitting image data wirelessly.¹ Appellants respectfully submit that these new assertions in support of the outstanding rejections are insufficient to satisfy the Examiner's burden in establishing *prima facie* obviousness.

a. The References Fail to Teach All the Elements of the Claimed Invention, Thus Failing to Establish *Prima facie* Obviousness of Independent Claim 1

Independent claim 1 is directed to an electronic camera including a body; a control part provided to the body, the control part being operated by a user; and a wireless communication

¹ Appellants note that this assertion directly contradicts the Examiner's support for the claim rejections. For example, with regard to claim 1 as set forth on pages 3-4 of the Examiner's Answer, the Examiner asserts *Freeman* discloses a camera-integrated device (1,2), which appears to contradict the Examiner's statement that she is not relying on the combination of the camera 1 and the remote unit 2 of *Freeman*. Appellants will refute the Examiner's claim rejections as best as the Appellants can understand them.

device, which transmits image data. The wireless communication device further transmits operation information corresponding with operation of the control part to an external apparatus to remotely control the external apparatus. Additionally, the wireless communication device transmits at least one of the image data and the operation information when the camera is within a predetermined distance of the external apparatus.

In maintaining the rejection of claim 1, the Examiner now asserts that *Watanabe* teaches all of the elements set forth in claim 1, except for transmitting the image data wirelessly. The Examiner admits *Watanabe* fails to teach this claim element and relies on the teachings of *Freeman*, asserting it is well-known to transmit image data wirelessly from a remote unit to an external apparatus. The Examiner further asserts that *Watanabe* already discloses the combination of a camera 20 integrated with a device 22 for transmitting image data citing to Fig. 1. Appellants respectfully disagree with these assertions.

As previously submitted, *Watanabe* discloses a camera-integrated type VTR 10 which has an editing function for editing video signals recorded on a recording medium such as magnetic tape, in conjunction with a stationary type VTR 11, which is remotely operable. The camera-integrated VTR 10 is provided with a recording and reproducing part 1 for recording and reproduction. The recording and reproducing part 1 includes a system control part 2 arranged to control the processes of the editing function as well as control over the whole apparatus, a remote-control signal transmitting part 3, a remote-control code storing part 4, and an input key group 5 provided for input of data of various kinds, a character generating circuit 6 and a viewfinder 7 (col. 7, line 62 - col. 8, line 7).

The remote video transmission system taught by *Freeman et al.*, however, discloses a device having the capacity to output a video signal 1, such as a video camera, video cassette

recorder/player, laser disc player, etc., and a remote unit 2 which is designed to be portable so that it can be transported and used in areas which are inaccessible or unsuited for a conventional desktop personal computer. In the preferred embodiment, *Freeman et al.* teaches the remote unit being a portable personal computer having a 486DX-2/66 motherboard, 10-inch plasma display, 210 MB notebook hard disk drive, MS DOS Vet. 6.2 operating system, Microsoft® Windows™ Ver. 3.1, Microsoft® Video for Windows, Procom Plus® for Windows, trackball bus mouse, high speed serial ports, 1 MB Windows accelerator video card, video capture card with capture module, audio capture card, SVGA to NTSC converter, SVGA video adapter. The remote unit also has up to four computer interfaces such as modems, each connected to a cellular telephone.

A signal is input into remote unit 2 from any device having the capacity to output a video signal 1, such as a video camera, video cassette recorder/player, laser disc player, etc. The video signal received by the remote unit can be of any generally known format, such as NTSC, PAL, and Y/C video (or S video). The remote unit 2 is designed to be portable so that it can be transported and used in areas which are inaccessible or unsuited for a conventional desktop personal computer. (Col. 4, ll. 17-36).

In other words, *Freeman* merely teaches two computers, namely the remote unit and the host unit, communicating wirelessly, as admitted by the Examiner in her Answer. However, Appellants submit that these teachings are insufficient to cure the deficiencies of the teachings of *Watanabe*. There is no teaching in *Freeman* that is directed to an electronic camera including a wireless communication device to transmit image data when the camera is within a predetermined distance of the external apparatus. Further, there is no teaching, as admitted by the Examiner, in *Watanabe* that is directed to this claim element. Thus, neither of these

references, either alone or in combination, assuming these references are combinable, which Appellants to not admit, teach or suggest this claim element.

b. The Teachings of the References Teach Away From the Purported Combination and Would Change the Principle of Operation of The Prior Art Being Modified

Watanabe teaches away from the purported combination as asserted by the Examiner. *Watanabe* seeks to provide a reproducing apparatus which can be produced at a low cost and which is simply operable for carrying out an editing function for editing information signals recorded on a recording medium. (*Watanabe*, col. 5, lines 43-48).

Further, *Watanabe* seeks to solve the problem where, when the VTR is operated in a normal mode by operating a key, such as a PLAY key, a STOP key, an FF key, a REW (rewinding) key, an FF search key or a REW search key, during an editing programming operation or while the editing operation is in process, a pinch roller and a capstan motor tend to be accidentally released from the state of being pressed into contact with each other. Under such a condition, according to the relative tape counting method, the count values of the cut-in and cut-out points would deviate from correct values. (col. 5, lines 27-37)

It is respectfully submitted that the resultant device as suggested by the Examiner would be a more sophisticated and more expensive machine that is not simply operable. Further, the Examiner's purported combination would change the principle of operation of the prior art being modified, namely changing the platform of the *Watanabe* system from analog to digital. This appears to be directly contrary to the object of the invention as recited by *Watanabe*, namely providing for a low cost and simply operable device and addressing issues that are involved in editing data recorded on tape.

In paragraph x. on page 14 of the Examiner's Answer, the Examiner purports to convert the *Watanabe* system from analog to digital. The Examiner asserts that the substitution of an image processor for a tape recorder would not destroy the principle operation of *Watanabe* because the principle operation is to store image data and that using an image processor only improves the *Watanabe* apparatus. Appellants respectfully disagree with these assertions.

As noted above, *Watanabe* seeks to solve 3 problems at col. 5, lines 14-37 as follows:

The conventional VTR of the kind mentioned above, however, presents problems which have been desired to be solved. One of the problems lies in that recorder keys, such as reproduction, stop and fast-feeding keys, and cut-in and cut-out input keys must be operated in a complex manner when programming the cut-in and cut-out points.

Another problem lies in that, when programming for editing, pictures are muted during the process of normal mode transition, such as FF (fast-feeding) .fwdarw. STOP (stopping) .fwdarw. PLAY (reproduction). Such muting makes a search for a desired editing point difficult because the desired point tends to pass unnoticed while pictures are in a mute state.

A further problem lies in the following point. When the VTR is operated in a normal mode by operating a key, such as a PLAY key, a STOP key, an FF key, a REW (rewinding) key, an FF search key or a REW search key, during an editing programming operation or while the editing operation is in process, a pinch roller and a capstan motor tend to be accidentally released from the state of being pressed into contact with each other. Under such a condition, according to the relative tape counting method, the count values of the cut-in and cut-out points would deviate from correct values.

The remotely operable external recording apparatus disclosed solves these problems. By converting the system to a digital system, as suggested by the Examiner, the principle of operation would surely be changed and, Appellants submit, the resultant device would render the prior art unsatisfactory for its intended purpose. As such, the Examiner's purported combination is clearly improper.

c. There is No Motivation to Combine the References as Asserted By the Examiner with Respect to Independent Claim 1

The disclosed elements that the Examiner has pieced together fail to render the pending claim obvious. As noted above, the claimed invention recites a wireless communication device transmitting at least one of the image data and the operation information when the camera is within a predetermined distance of the external apparatus. *Watanabe* is not at all concerned about performing a particular operation depending upon the proximity of the camera-integrated type VTR with the stationary type VTR. Neither is *Freeman*. In fact, *Freeman* assumes that the remote unit is particularly far away from the host unit. As such, the Examiner's assertions that the combination of the cited references render the pending claim obvious amounts to impermissible hindsight. The Examiner must be utilizing Appellants' own specification to conclude that these teachings render claim 1 obvious. It is well established that this practice is improper.²

In paragraph iv on page 12 of the Examiner's Answer, the Examiner states that by using the combination of *Watanabe* and *Freemen*, the teaching of transmitting image data through signal lines as described by *Watanabe* would be replaced by a wireless device as taught by *Freeman* to transmit the image data.³ As noted above, and fully set forth in Appellants' Appeal Brief, the wireless device taught by *Freeman* is a personal computer as depicted as remote unit 2. The Examiner's reliance on these teachings does not satisfy the Examiner's burden in establishing *prima facie* obviousness for reasons as previously noted on the record. There is simply no motivation to combine the references as asserted by the Examiner, other than the teachings that are disclosed in Appellants' own disclosure.

² *In re McLaughlin*, 443 F.2d 1392,1395, 170 USPQ 209, 212 (CCPA 1971)

³ This assertion appears to contradict at least the statement made in paragraph iv on page 12 of Examiner's Answer.

2. THE EXAMINER INTRODUCES SUPPORT FOR HER REJECTION OF CLAIM 24 BY ASSERTING THAT THE *PETERS* REFERENCE CURES THE DEFICIENCIES OF THE PRIMARY AND SECONDARY REFERENCES

In response to Appellants' arguments regarding claim 24, the Examiner merely repeats her rejection asserting "See the rejection of claims 5 and 20 above." However, in paragraph xi. on page 15 of Examiner's Answer, the Examiner asserts as follows:

Peters teaches detecting other devices that include radio modems when coming into radio proximity. *Peters* also teaches that communication is established (data is transmitted) with another device upon coming into proximity (col. 4, lines 47-50). *Freeman* teaches using a radio modem to transmit image data (col. 2, lines 26-31). Therefore, between the combination of *Watanabe* and *Freeman* and *Peters* it would have been obvious that the camera could transmit at least one of the image data and the operation information automatically when the camera is within a predetermined distance of the external apparatus.

It is respectfully submitted that these assertions still fail to rise to the level of *prima facie* obviousness. The Examiner provides no motivation in support of these assertions and Appellants maintain that by piecing the teachings of the cited references together, the only source of motivation is the Appellants' own specification, which amounts to impermissible hindsight.

Further, these assertions fail to teach automatically transmitting image data wirelessly from the electronic camera to the external apparatus based upon the determination that the electronic camera is within a predetermined distance of the electronic camera as recited in claim 24. Assuming, *arguendo*, the Examiner's assertions, *Peters* merely teaches detecting other devices when coming into proximity. *Freeman* merely teaches wirelessly transmitting image data from one computer to another computer. These teachings are insufficient to teach **automatically** transmitting image data wirelessly from the electronic camera to the external apparatus based

upon the determination that the electronic camera is within a predetermined distance of the electronic camera. As the Examiner has failed to provide references that teach or suggest all of the claim elements, in addition to failing to provide proper motivation, Appellants maintain that the Examiner has failed to satisfy her burden in establishing *prima facie* obviousness.

CONCLUSION

For all the reasons set forth above and for the reasons contained in the original Appeal Brief, Appellants respectfully submit that all pending claims of the present application are allowable. Thus, favorable reconsideration and reversal of the Examiner's rejection of claims 1-7 and 9-24 by the Honorable Board of Patent Appeals and Interferences is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present Appeal, the Examiner or the Honorable Board is respectfully requested to contact Catherine M. Voisin (Reg. No. 52,327) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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